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10/674,692

09/30/2003

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T-6172A (538-58)

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11/30/2006

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,692

Applicant(s)

ROBY ET AL.

Examiner

Joseph D. Anthony

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-5 and 9-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

FINAL REJECTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 9-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Culpon, Jr. U.S. Patent Number 5,151,205.

Culpon, Jr. teaches a lubricating composition for chain and gear drive mechanisms. The composition comprises a polyalphaolefin base oil (none of which are disclosed to contain any phosphorous content at all), an ester oil solubilizer (such as trimethylol propane ester of C₈-C₁₀ normal carboxylic acids or trimethylol propane ester of C₇-C₉ normal carboxylic acids) that read directly on applicant's claimed polyol ester of the listed general formula in claim 1, and 2 to 4 wt % of a polybutene tackifier, see abstract, column 1, line 60 to column 2, lines 49 and TABLE 2. The preferred concentration range of the claimed trimethylol propane ester solublizer of C₆ to C₁₂ carboxylic acid is between 5 to 30 wt.%, see claims 1-2. The lubricating composition can contain optional additives such as extreme pressure and antiwear additives which may contain sulfur and phosphorus see Table 2 and claim 17. The composition replaces a mineral oil formulation and demonstrates persistent lubricity and substantially reduced smoking in chain and drive gear assemblies operated at high temperatures, see abstract.

Applicant's claims are deemed to be anticipated over the lubricating oil composition according to claims 1-2 when the concentration of the trimethylol propane

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ester solublizer of C₆ to C₁₂ carboxylic acid is at 5 wt.%. Please note that the synthetic base lubricating oil component in said lubricating oil composition, does not contain any phosphorous content at all. As such, applicant's claimed limitation of: "wherein the composition has a phosphorous content not exceeding 0.08% by weight, based on the total weight of the composition" is inherently met. The addition of extreme pressure and antiwear additives which may contain sulfur and phosphorus are not required components, see independent claim 1, and are directly claimed to be only optional components, see dependent claim 17.

In the alternative, Culpon, Jr. could be said to differ from applicant's claimed invention only in that there is not a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since the patent directly disclosed and claims that a preferred concentration amount for the trimethylol propane ester solublizer of C₆ to C₁₂ carboxylic acid is 5 wt.%, see claim 2.

Response to Arguments

4. Applicant's arguments filed 10/25/06 have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next. The body of the above prior-

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art rejection clearly rebuts applicant's argument that the Culpon Jr. Patent neither teaches nor suggests a polyol ester at a concentration amount that falls within applicant's claimed concentration amount. Likewise the body of the above prior-art rejection clearly rebuts applicant's argument that the Culpon Jr. Patent does not disclose a lubricating composition that meets applicant's claimed limitation concerning the maximum phosphorous concentration amount.

The two previously made provisionally ODP rejections have been dropped. The provisional ODP rejection over S.N. 10/674,643 has been dropped because of applicant's amendments to the claims in said application. The provisional ODP rejection over S.N. 11/046,994 has been dropped because it is now not deemed to be warranted.

The previously made prior-art rejections that have been dropped have been dropped for the reasons of record found in applicant's response of 10/25/06.

Finally, the examiner has review both IDS statements filed after the first office action. The following two references: 1) EP 0 654 524 A2 and 2) U.S. Patent Number 5,958,089, which were applied in the "Written Opinion" over applicant's claims by the Austrian patent Office are not deemed to be applicable over applicant present claims since they teach the use of 0.001 to 0.5% by weight of esters according to applicant's composition as an additive to oils and/or fuels. This concentration amount is outside of applicant's claimed concentration amount.

The "Written Opinion" applied WO 99/18175 reference is deemed to be a very good reference, that could be applied under 35 USC 102(b)/103(a) over all of

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applicant's claims but is not presently be applied because it is deemed to be redundant over the Culpon Jr. Patent.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

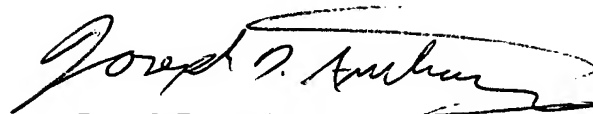
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be

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treated as Official communications and cannot be immediately handled by the
Examiner.

A handwritten signature in black ink, appearing to read "Joseph D. Anthony", with a stylized flourish at the end.

Joseph D. Anthony
Primary Patent Examiner
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1/1/25/06